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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|-----------------------|------------------|
| 10/824,915 | 04/15/2004 | Stephen Selle | 8206 | 7341 |
| 7590 | 10/31/2005 | | EXAMINER | |
| (WOODLING, KROST AND RUST) KENNETH L. MITCHELL 9213 CHILlicothe ROAD KIRTLAND, OH 44094 | | | SHARP, JEFFREY ANDREW | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3677 | |

DATE MAILED: 10/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|------------------------|---------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/824,915 | SELL, STEPHEN |
| | Examiner | Art Unit |
| | Jeffrey Sharp | 3677 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 30 August 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-11 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 15 April 2004 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

[1] This action is responsive to Applicant's remarks/amendment filed on 30 August 2005 with regard to the Official Office action mailed on 11 July 2005.

Status of Claims

[2] Claims 1-11 are pending.

Claim Objections

[3] Claim 8 is objected to because of the following informalities:

The word "devices" in the preamble should be --device--.

Appropriate correction is required.

Response to Arguments/Remarks

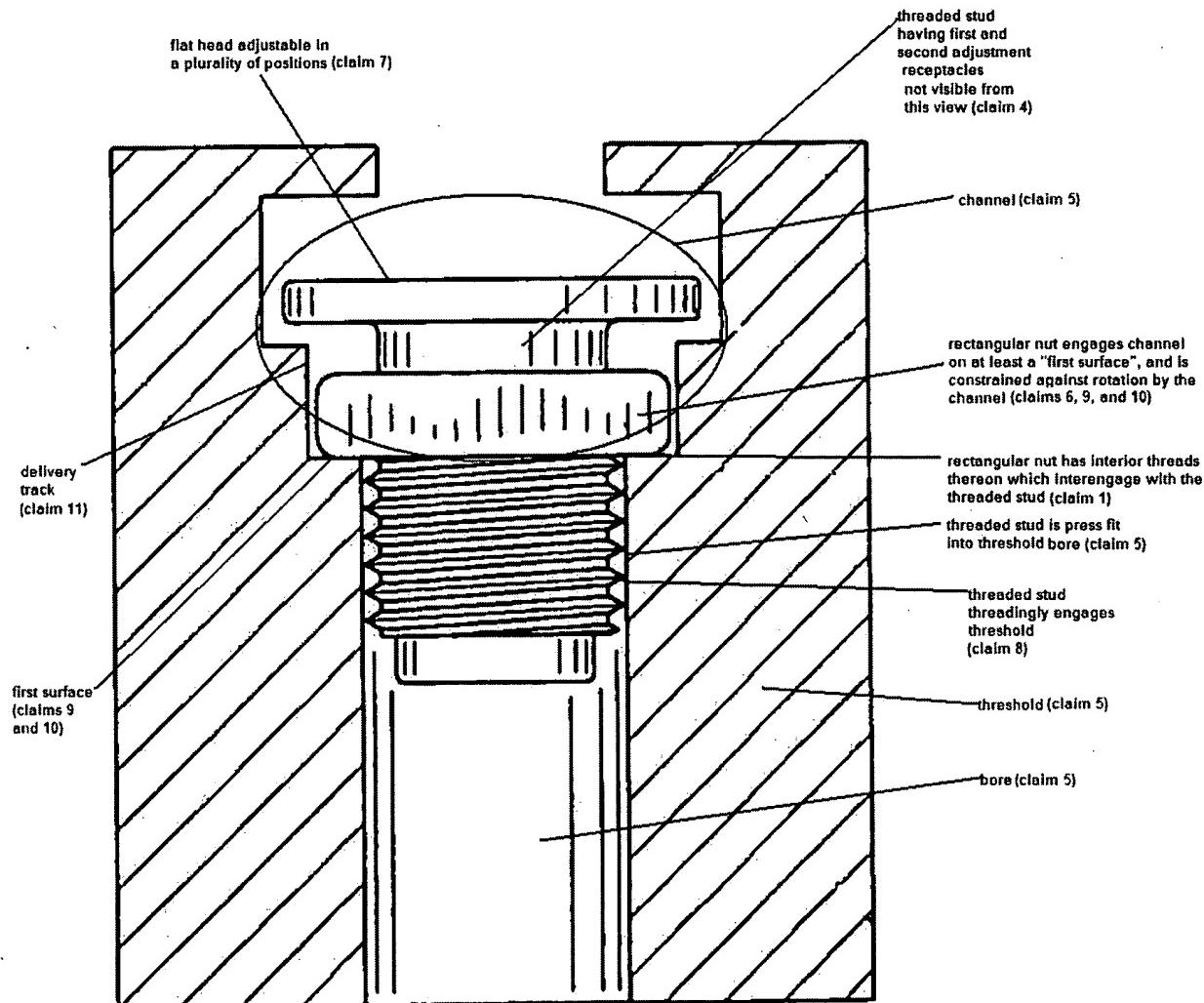
[4] Claim(s) 1-11 were previously rejected under 35 U.S.C. 103(a) as being obvious over Applicant's admission of prior art, in view of Selle US-2003/0049097 (now US-6,640,968) or Liestner US-6,209,722.

Applicant's arguments/remarks with regard to this reference have been fully considered, but are not persuasive. Accordingly, these rejections are maintained.

In response to Applicant's assertion that the examiner has not demonstrated a prima facie case of obviousness, the examiner would like to more clearly point out why claims 1-11 were rejected under 35 U.S.C. 103(a) as being obvious over Applicant's admission of prior art, in view of Selle US-2003/0049097 (now US-6,640,968) or Liestner US-6,209,722.

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The delivery track shown in the drawings could be broadly construed as a "threshold" having a "channel" with a "bore therein". The examiner takes the position that all elements except for a raised crown and flanges are expressly disclosed in the prior art figures of the instant application.



(PRIOR ART)

Selle US-2003/0049097 (now US-6,640,968) broadly suggests placing flanges at either end of a fastener when the fastener is in a channel of a delivery track (e.g., 'threshold'). This prevents jamming and/or shingling of said fasteners.

Liestner US-6,209,722 suggests flanges at first and second ends of u-shaped nuts when said nuts are in a channel of a delivery track (e.g., 'threshold'). This prevents jamming and/or shingling of said nuts when transported through a delivery track. Liestner also makes obvious employing a "raised crown having interior threads thereon", in order to provide a longer length of engagement to said u-shaped nuts, especially when it is desired to manufacture said nuts from sheet material to reduce weight and manufacturing costs (as evidenced by previously cited Kellogg US-1,773,146).

In response to Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to Applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both Selle and Liestner suggest raised flanges at the ends of track-fed fasteners to prevent shingling.

In response to Applicant's argument that a "raised flange" is not taught by either of the teaching references (herein, Selle and Liestner), the Applicant is reminded that claims in a pending application should be given their broadest reasonable interpretation. *In re Pearson*, 181

USPQ 641 (CCPA 1974). In the instant case, a "pawl" may be broadly construed as a "raised flange".

flange

n : a projection used for strength or for attaching to another object.

Source: WordNet ® 2.0, © 2003 Princeton University

flange (flānj)

n.

1. A projecting rim or edge.

Source: The American Heritage® Stedman's Medical Dictionary

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In response to Applicant's remarks that the examiner has not provided evidence of why a person of ordinary skill in the t-nut art would look at threshold adjustable fasteners, Applicant is directed to cited US-6,185,870 to Mettler, which shows a t-nut (12) in an "adjustable threshold assembly", said t-nut having flanges (26, 27) -- some (26) of which reside in a channel of a threshold (14), said assembly further comprising a threaded stud (1) being press fitted into a threshold bore (16), said stud (1) having adjustment receptacles (8,9). Therefore, it would not be "unobvious" for a worker in the art to combine the references.

New Grounds of Rejection

Claim Rejections - 35 USC § 112

- [5] The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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- [6] Claim 4 is currently rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear as to what "first and second adjustment receptacles" are (threads? means for applying torque?). This claim has been treated as it is definite (adjustment receptacle generally being a "torque transmitting recess" or the like)

Claim Rejections - 35 USC § 102

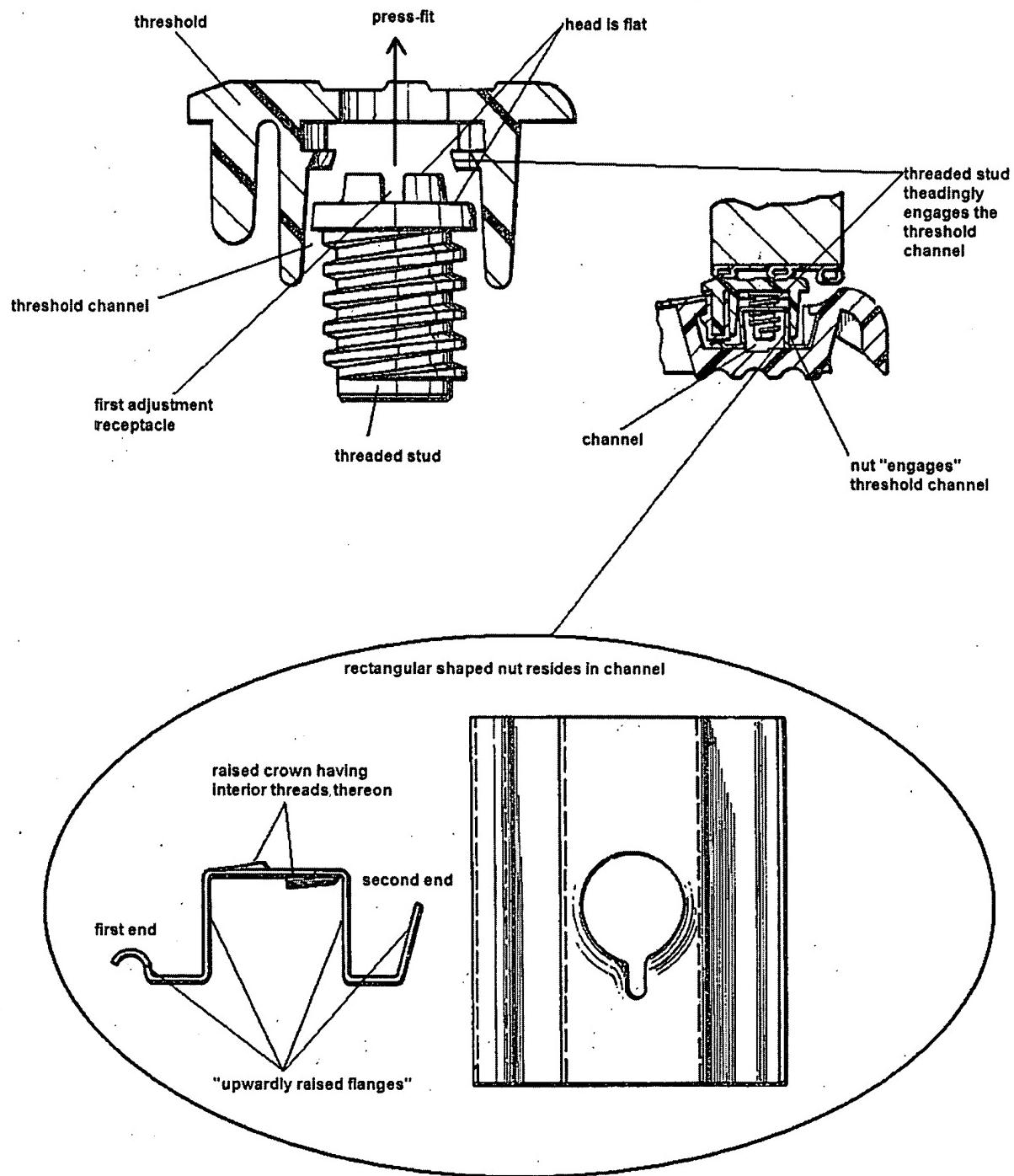
- [7] The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

- [8] Claims 1-3, and 5-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Bursk et al. US-4,352,258.

In short, Bursk substantially teaches each and every limitation found in claims 1-3, and 5-11 as clearly shown in the annotated drawing below.



[9] Claim 11 is rejected under 35 U.S.C. 102(b) as being anticipated by Selle US-5,993,320.

In short, Selle already discloses a delivery track comprising generally u-shaped nuts "adapted" to receive a threaded stud (not positively claimed), each of said nuts having a forward and rearward flange to prevent excessive rotation or vertical displacement of the fastener (not positively claimed). See Selle US-5,993,320, figures 1-6 and columns 1-2.

Claim Rejections - 35 USC § 103

[10] The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

[11] Claim 4 (as it is understood) is rejected under 35 U.S.C. 103(a) as being unpatentable over Bursk et al. US-4,352,258.in view of Mettler US-6,185,870.

Bursk et al. teaches each and every limitation of claim 1, including a first adjustment receptacle.

However, Bursk et al. fails to disclose expressly a second adjustment receptacle.

Mettler suggests two adjustment receptacles (8,9) so as to: 1) provide a means for use with either a slotted head or Phillips head driver, 2) enable a finer tuned adjustment, and/or 3) to lighten the weight of the threaded stud in order to save on material costs. Applicant further admits in prior art figures 1a and 1b, that such threaded studs conventionally have at least two "adjustment receptacles"

At the time of invention, it would have been obvious to one of ordinary skill in the art, to modify the threaded stud taught by Bursk et al. by employing a second adjustment receptacle, in order to 1) provide a means for use with either a flat head or Phillips head driver, 2) enable a finer tuned adjustment, and/or 3) to lighten the weight of the threaded stud in order to save on material costs.

Conclusion

[12] The prior art made of record and not relied upon is considered pertinent to applicant's disclosure is as follows:

US-3,962,828 to McAllister appears to read on at least claims 1-3, and 5-10, and would be a suitable 35 USC § 102(b) reference for these claims.

US-4,040,228 to Skubic appears to read on at least claims 1-3, and 5-8, and would be a suitable 35 USC § 102(b) reference for these claims.

US-596,948 to Seely appears to read on at least claims 1-3, and 5-7, and would be a suitable 35 USC § 102(b) reference for these claims.

| | | |
|---------------|-------|-------------------------------|
| US 6550999 B2 | USPAT | Petit; Robert et al. |
| US 5239728 A | USPAT | Redman; Ronald E. |
| US 5230181 A | USPAT | Geoffrey; David C. et al. |
| US 5205092 A | USPAT | Taylor; Brian J. |
| US 5010690 A | USPAT | Geoffrey; David C. |
| US 3983388 A | USPAT | Gugliotta; George |
| US 3900967 A | USPAT | Bursk; William Michael et al. |

| | | |
|-------------------|----------|--------------------------|
| US 3816746 A | USPAT | Gugliotta; George et al. |
| US 20050210754 A1 | US-PGPUB | Ferrell, Robert W. |
| US 20040200153 A1 | US-PGPUB | Khanlarian, Haik |
| US 20040200152 A1 | US-PGPUB | Khanlarian, Haik |
| US 0646465 A | USPAT | Seely |

[13] THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

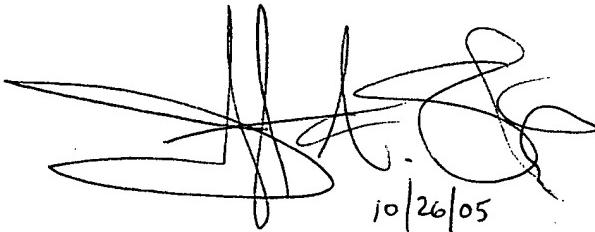
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

[14] Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Sharp whose telephone number is (571) 272-7074. The examiner can normally be reached 7:00 am - 5:30 pm Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann can be reached on (571) 272-7075. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JAS



10/26/05



ROBERT J. SANDY
PRIMARY EXAMINER